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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,946	10/04/2000	Deborah L. Caswell	10005371-1	2912

22879 7590 08/20/2004

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EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/684,946	CASWELL ET AL.
Examiner	Art Unit	
Benjamin E Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 October 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6, 13-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim1-5, 7-8, 15 of copending Application No. 09/704,394. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the current application and copending Application '395 claim a web server system that comprises a web server that generates content regarding a physical entity in response to external requests, a location beacon adjacent to the physical entity to transmit a first beacon signal containing the web address and a second beacon signal containing a web address and a encrypted token, and a location authentication module that authenticates service requests by checking the token that accompanies the request with the respect to the token that was sent out in the second beacon signal .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-15 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 09/633,077 in view of Kirsch, U.S. Patent 5,963,915. Both the current application and the copending application '077 disclose a web server system with:

A web server that hosts the content corresponding to a physical entity that is accessed externally via a web address.

A location beacon adjacent to the physical entity that transmits a beacon signal comprising a web address of the web site for the physical entity along with a token that has an expiration period.

A location authentication module that restricts access to the web server to requests that contain the proper unexpired token.

The difference between the applications is that the present application discloses the encryption of the token. It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the tokens in order to provide a secure venue for commercial transactions as taught in Kirsch (Col. 1, lines 54-56).

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 6 recites the limitation "the random number key" in lines 5-6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-4, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy, U.S. Patent No. 6,199,753, in view of Kirsch, U.S. Patent No. 5,963,915. Referring to claims 1, 2, 13, Tracy discloses a portable shopping system wherein a central host (location beacon) transmits electronic coupons (token) along with a web page link (web address)(Col. 12, line 59 – Col. 13, line 40), which meets the limitation of a

location beacon adjacent to the physical entity to transmit a first beacon signal containing the web address and a token that expires within a predetermined time period, that is receivable by a customer's portable terminal (Fig. 2, Fig. 4). Tracy discloses that the transmission can be encrypted (Col. 6, lines 23-25), but does not disclose that the token is

encrypted. Kirsch discloses a system for secure internet transactions wherein upon user registration the user is provided with a cookie (token) that contains a server domain name and an expiration date (Col. 3, lines 13-20). When the user requests the URL of the web server (second request), the cookie is encrypted with the private key of the user and sent to a server (location authentication beacon) to be validated (Col. 13, lines 15- 45), which meets the limitations of a location authentication beacon adjacent to the physical entity to transmit a second beacon signal containing the web address and a customized token encrypted using a key and a location authentication module that retrieves the key from a first request from a client system that has captured the first beacon signal if the first request contains the key and the token that has not expired, and causes the web server to service a second request from the client system if the second request contains the customized token that has not expired. It would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the coupons (token) of Tracy in order to provide a secure venue for commercial transactions as taught in Kirsch (Col. 1, lines 54-56).

Referring to claim 3, Tracy discloses the use of coupons in the portable shopping system and by definition coupons expire.

Referring to claim 4, Tracy discloses that this system works only within the store (Col. 3, lines 38-67), which meets the limitation of a predetermined transmission range.

10. Claims 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy, U.S. Patent No. 6,199,753, in view of Kirsch, U.S. Patent No. 5,963,915 as applied to claim 1 above, and further in view of Schneier. Referring to claims 5-8, 13, Tracy discloses a portable shopping system wherein a central host (location beacon)

transmits electronic coupons (token) along with a web page link (web address)(Col. 12, line 59 – Col. 13, line 40), which meets the limitation of a location beacon adjacent to the physical entity to transmit a first beacon signal containing the web address and a token that expires within a predetermined time period, that is receivable by a customer's portable terminal (Fig. 2, Fig. 4). Tracy discloses that the transmission can be encrypted (Col. 6, lines 23-25), but does not disclose that the token is encrypted. Kirsch discloses a system for secure internet transactions wherein upon user registration the user is provided with a cookie (token) that contains a server domain name and an expiration date (Col. 3, lines 13-20). When the user requests the URL of the web server (second request), the cookie is encrypted with the private key of the user and sent to a server (location authentication beacon) to be validated (Col. 13, lines 15- 45), which meets the limitations of a location authentication beacon adjacent to the physical entity to transmit a second beacon signal containing the web address and a customized token encrypted using a key and a location authentication module that retrieves the key from a first request from a client system that has captured the first beacon signal if the first request contains the key and the token that has not expired, and causes the web server to service a second request from the client system if the second request contains the customized token that has not expired. Kirsch does not disclose that the encryption keys are random. Schneier discloses the use of randomly generated encryption keys (page 173). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use encryption keys generated randomly because randomly generated encryption keys are generally stronger as taught in Schneier (Page 173).

Referring to claim 9, Tracy discloses the use of coupons in the portable shopping system and by definition coupons expire.

Referring to claims 10, 15, Tracy discloses that this system works only within the store (Col. 3, lines 38-67), which meets the limitation of a predetermined transmission range.

*Drawings*

11. New corrected drawings are required in this application because lines, letters, and numbers are not uniformly thick and well defined, clean, durable, and black. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 703-305-7684. The examiner can normally be reached on M-Th 0 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703)305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



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